

## **REMARKS**

Claims 1 and 42 are currently amended. Claims 1-44 are pending in the application.

### **Specification Objections**

The Examiner maintains the objection to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully traverses this rejection. The Specification, as an example, states that a peer may be a “computer, a telephone, set top box, a network appliance, gaming console, entertainment device, or any device capable of connecting to the network 145” (see Specification, ¶[0026]; the Specification also recites:

“The hardware portions of a peer (e.g., storage devices, memory, microprocessor, buses, etc.) are not illustrated, and can be of any conventional or equivalent design.” Specification, p.12, ¶[0032].

Claims 33-41 have were amended to recite: “A non-transitory, computer readable program storage device encoded with instructions that, when executed, perform a method for sharing an active content of a sender peer with a recipient peer....” As the specification discloses, one of skill in the art would know that a computer comprises various computer readable program storage devices encoded with instructions (e.g., hard drives, CD-ROMs, DVDs, floppy disks, RAM, storage devices, etc.). As such, the Specification provides antecedent basis for “a non-transitory, computer readable program storage device encoded with instructions....” Therefore, based upon the disclosure in the Specification, those skilled in the art would find, explicitly and/or implicitly, all of the elements of a non-transitory, computer readable program storage device encoded with instructions, as called for by claims 33-41.

In the Final Office Action, the Examiner recommended that Applicant amend the Specification to recite “computer readable program storage devices” without adding new matter. Applicant has done so as shown in the “In The Specification” section above in this Response. As

such, Applicant respectfully requests that the Examiner's objection to the Specification be withdrawn for at least these reasons.

**Claims Rejections Under 35 U.S.C. §101**

The Examiner maintained the rejections of claims 1-21, 42-44 under 35 U.S.C. §101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner rejected claim 1 for having recited a system comprising a sender peer and a recipient peer, wherein each peer comprising modules. The Examiner asserts that because the Specification recites that "in general, a peer is some type of computing device (physical or virtual)," the claim is allegedly strictly software due to the reference to the "virtual" description. However, Examiner's own assertion indicates that the disclosure in the Specification recites that the computing device may be **physical**. Further, virtual components may also be linked with physical components. Nevertheless, the Specification clearly describes that a peer may be a "physical device." Since it is undisputed that the "sender peer" includes an embodiment that is described to be physical, it is of proper statutory subject matter.

In order to expedite prosecution, Applicant has amended the rejected claims to recite: "a first (second) processor, that when programmed, is adapted to execute" (claims 1-21) as well as "a processor, that when programmed, is adapted to execute" (claims 42-44). A "processor" is clearly statutory subject matter, as are "hardware processing devices", in addition to the sender and recipient peers being statutory subject matter, therefore claims 1-21 and 42-44 are all statutory subject matter.

Accordingly, Applicant respectfully submits that the amended claim language meets all standards of 35 U.S.C. §112, and as a result, the claims are in condition for allowance.

Therefore, the rejection of claims 1-21 and 42-44 should be withdrawn for at least the reasons cited herein.

**Claim Rejections Under 35 U.S.C. §102**

The Examiner rejected claims 42 and 44 under 35 U.S.C. §102(e) as being anticipated by US Application 2003/0225834 (*Lee*). Applicant respectfully traverses this rejection for at least the same reasons discussed below with respect to claim 1.

**Claim Rejections Under 35 U.S.C. §103**

The Examiner rejects claims 1-8, 18-24, 27-35 and 37-41 under 35 U.S.C. §103(a) as being unpatentable over *Lee* in view of U.S. Patent No. 6,757,732 (*Sollee*). Applicant respectfully traverses this rejection.

For ease of illustration, claim 1 is discussed first. Claim 1, directed to a system, recites *inter alia* sending active content and at least one chat message using a chat module communications path between first and second chat modules. The Examiner's rejection is incorrect because *Lee* and *Sollee*, either alone or in combination, do not disclose or suggest at least one of the elements of independent claims 1, 22, 33, and 42.

For example, claim 1 recites sending active content and at least one chat message using a chat module communications path. The Examiner admits that *Lee* does not teach this claimed feature. *See* Final Office Action, p.8. The Examiner, however, now argues that *Sollee* teaches this claimed feature because *Sollee* describes communications over a data network on one communications path. *See id.* The Examiner's position, however, is problematic for several reasons. First, the Examiner incorrectly states that just because *Sollee* teaches chat messages and multimedia data on a single communications path, this allegedly teaches sending active content and at least one chat message using a chat module communications path. In fact, *Sollee* does

not teach this claimed feature. *Sollee* teaches that call sessions over data networks may be established during which multiple types of data may be transmitted. See *Sollee*, col. 3, ll. 2-65. Simply sending chat messages on a voice/data network path during a telephone/voice call session does NOT make the voice/data network path a chat module communications path, as recited in claim 1 and exemplified in the Specification. By nature, the network paths used in *Sollee* are *high bandwidth networks* which may accommodate multimedia, voice and data sessions. *Id.* In other words, *Sollee* teaches that a chat session may be implemented *over a high bandwidth call session*, and not active content and at least one chat message being sent using a chat module communications path, as recited in claim 1. In the Final Office Action, the Examiner argues that networks having high bandwidth are not exempted from being chat module communications paths, as recited in claim 1. The Examiner, however, is not taking the claim language in view of the Specification. The instant Specification and Figures describe chat module communications paths as having a centralized messenger service thru which chat communication paths run. "The chat module 210 connects to a centralized messenger service located on the network 145 to set-up and/or conduct communication with other peers." Specification, ¶[0033]. In contrast, *Sollee* teaches that communications take place over a session initiation protocol (SIP) or other similar protocol that use SIP servers and endpoints. That is, *Sollee* does not teach using a centralized messenger service for chat module communications paths, as called for in claim 1 and as taught in the instant Specification.

Moreover, *Lee* fails to make for the deficit of *Sollee*; the Examiner correctly does not rely upon *Lee* for the claimed feature of an active content and at least one chat message being sent using a chat module communications path. Therefore, the combination of *Sollee* and *Lee* fails to teach or suggest an active content and at least one chat message being sent using a chat

module communications path. Accordingly, combination of *Sollee* and *Lee* do not teach or make obvious all of the elements of claim 1.

Second, even assuming *arguendo* that *Sollee* teaches the claimed feature of sending active content and at least one chat message using a chat module communications path, such a teaching is incompatible with the teachings of *Lee*. It is well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). It is also well established that where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination. *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). That is, if the proposed combination undermines the purpose of the prior art, it cannot be obvious. Here, the Examiner proposes modifying *Lee* with the teachings of *Sollee* that would render inoperable functionality taught in *Lee*.

Here, the Examiner proposes combining the high bandwidth connection of *Sollee* into the dual network implementation (chat network and high bandwidth network) of *Lee*, in an attempt to teach the claimed subject matter. This attempted combination is not proper, however, at least because the combination would render inoperable the dual network implementation found in *Lee*. *Lee* teaches that two separate networks are used to transfer chat and other, high bandwidth data. *See Lee*, Fig. 2 (30) & ¶[0065]-[0067] (stating “if the inviter computer determines at step 908 that the invitee has accepted the invitation, then the inviter computer attempts to establish a content sharing session on a second, or “content sharing,” communication path 30 (see FIG. 2), between the inviter computer and the invitee computer.”) (*emphasis added*). *Lee* is teaches

that the messaging application **does not** transfer content over the messaging communication path, rather a “second,” separate connection (30) must be made to accommodate the high-bandwidth content transfer. It should be noted that the separate connection (30) is point-to-point and **does not** pass through the web/communications servers 10a/10b. This is because the separate connection (30) is **not** utilized by the messaging module, as can be seen by a complete reading of *Lee*. It is respectfully submitted that Applicant’s position is further bolstered by the fact that *Lee* (which teaches that chat communications paths are low bandwidth and require separate, high-bandwidth connections to transmit large files) was filed over two years *after Sollee*. That is, the Examiner cannot reasonably expect to combine *Sollee* with *Lee* as argued at least because *Lee* teaches a different network configuration (requiring two separate paths), and *Lee* was written with *Sollee* as prior art.

As such, because the combination would render inoperable the sharing implementation in *Lee*, in addition to the fact that *Lee* teaches a “second,” separate connection (30) must be made to accommodate the high-bandwidth content transfer, *Sollee* teaches away from *Lee* and their combination is improper.

With respect to teaching away, the courts have said: “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the application. The degree of teaching away will of course depend on the particular facts; in general a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 31 U.S.P.Q.2d (BNA) 1130, 1131 (Fed. Cir. 1994). *Lee* teaches that the messaging application **does not** transfer content over the messaging communication path,

rather a “second,” separate connection (30) must be made to accommodate the high-bandwidth content transfer. That is, *Lee* and *Sollee* would have suggested to a person of ordinary skill in the art that “that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *See id.*

Third, without using *improper hindsight* reasoning and using the claim as a roadmap, a person of ordinary skill in the art would have no apparent reason to modify the cited references to arrive at the subject matter of claim 1. The Examiner essentially provided a conclusory statement that adding the features of these references together would make for a better product; *i.e.*, the Examiner has simply stated the result of such a combination. *See* Office Action, p.8 (stating that the combination would be obvious “in order to send both the active content and the text-based chat messages thereby providing the advantage of not having to open up additional ports or setting up additional communications sessions to send desired text or multimedia data”). As such, the Examiner has merely stated that such a combination would have been obvious. However, the Examiner has not pointed to any teachings in the cited references that would **motivate** a person of skill in the art to combine the references. In other words, the question that must be addressed includes “*why* would a person have thought to combine the cited references based on their teachings?”, and “*what* was the need?”, not simply “what benefits would result?”.

In the Final Office Action, the Examiner simply states that combining *Lee* and *Sollee* would provide a user with the benefits of each disclosure. This type of argument amounts to no more than circular reasoning. Appellants respectfully submit that such a statement is conclusory, motivated by *improper hindsight*, and without support. Appellants respectfully request that the Examiner provide a motivation to combine/substitute that does not rely inherently upon the result of such a combination. In other words, a conclusory statement that a combination would

be obvious because so combining would provide some benefit is without basis and relies entirely upon the result to provide motivation. Appellants respectfully assert that the Examiner must point to a teaching or motivation in the cited art (either explicit or inherent) that shows **where** and **why** a person of skill in the art would have had a need to combine/substitute. In light of the fact that *Lee* specifically discusses how a second network path is needed for high bandwidth transfers (*Lee*, Fig. 2 (30) & ¶[0065]-[0067]) while *Sollee* describes an all-high bandwidth approach, the Examiner must show some need, not merely a result-oriented statement. Motivation to combine aside, as discussed above, even if *Lee* and *Sollee* were to be combined, claim 1 as a whole would be untaught and non-obvious over the references.

As such, independent claims 1, 22, 33, and 42 are allowable for at least the reasons cited herein. Further, respective dependent claims 2-21, 23-32 and 43-44 are also allowable for at least the reasons cited herein.

#### Claims 22, 33 and 42

Claims 22, 33 and 42 are discussed next. Claim 22 calls for real time media content sharing through a chat network connection, which as described above, relate to subject matter that is not taught, disclosed or suggested by *Lee*. Claim 33, which calls for communications similar to claim 1 is also not taught, disclosed, or suggested by *Lee* for similar reasons. Claim 42 calls for a graphical user interface (GUI) for outputting content information from a sender peer upon receiving one or more unique identifiers based upon shared active content. *Lee* does not disclose any type of a GUI for outputting active content based upon receiving unique identifiers relating to shared active content. *Sollee* fails to remedy the fundamental deficiencies of *Lee*; *Sollee* is concerned with SIP connections (and other similar networks) which can support different communications sessions. Accordingly, claims 22, 33 and 42 are also allowable.

## Claim 2

Claim 2 is discussed next and is allowable for at least additional features recited therein. Claim 2, depending from claim 1, calls for the second chat module further comprising a client module for requesting a stream of the active content and the first chat module further comprises a server module for sending the stream of active content in response to the request. The Examiner's rejection is improper because *Lee* fails to teach at least one of the claimed features. For example, *Lee* does not teach the claimed feature of requesting a stream of the active content. In the Final Office Action, the Examiner argues this feature is taught by *Lee*. *See* Final Office Action, p.9. In particular, the Examiner argues that a dynamic download (streaming, according to the Examiner) performed by the receiving machine teaches this feature. *See id.; see also Lee, ¶[0075]*. *Lee*, however, teaches that a receiving machine may download a media file from a first machine, and that the receiving machine may begin to play the stored portion of the media file before the entire file is received. *See Lee, ¶[0075]*. This disclosure does not amount to subject matter that could anticipate the stream of active content using peer to peer communication of claim 1. In contrast to *Lee*, claim 2 calls for requesting a stream of the active content. A stream of active content, for example, would be an audio file from the first machine *as it was being listened to* by a user at the first machine. *See, e.g.*, Specification, ¶[0004], for an exemplary description of active content. In *Lee*, the file is played at some later time after it is received, and playing will only commence when it is determined that *the entire file will be downloaded before it finishes playing*. Such a teaching does not anticipate the stream of active content in claim 2. Therefore *Lee* does not, and cannot, teach the claimed feature of claim 2.

Additionally, claim 2 calls for a server module for sending the stream of active content in response to the request. As discussed above with respect to the claimed feature of requesting a

stream of the active content, *Lee* fails to teach or suggest such a feature. In the Final Office Action, the Examiner argues that *Lee* teaches a “request action” for the content in ¶[0078]. See Final Office Action, p.9. Applicant respectfully submits that the Examiner is not viewing the claimed feature in light of the entire claim. *Lee* teaches that files may be shared between clients. *Lee* also teaches that during a file transfer, the receiving client may begin to execute the received file before the entire transfer is complete, but playing will only commence when it is determined that *the entire file will be downloaded before it finishes playing*. In other words, a first client may copy a media file to a second client, and the second client may begin to play the stored portion of the file before the entire file is saved. This disclosure, however, does not describe active content streaming. Streaming does not transfer files between clients. Streaming would allow a first client to view/listen to a file broadcast by a second client without a request to copy the file as in *Lee*. *Lee* teaches file sharing, not streaming. *Sollee* fails to remedy the fundamental deficiencies of *Lee*; *Sollee* is concerned with a high-bandwidth voice connection which can support different communication types.

As such, *Lee* and *Sollee* do not, and cannot, teach a server module for sending the stream of active content in response to the request, as called for in claim 2. For at least the aforementioned reasons, claim 2 is allowable. Claims 3-5 are also allowable for similar reasons.

#### **Claims 9-11, 13-17, 25-26 and 36; Claim 43**

The Examiner rejects claims 9-11, 13-17, 25-26 and 36 under 35 U.S.C. 103(a) as being unpatentable over *Lee* and *Sollee* in view of U.S. Patent No. 7,080,030 (*Eigen*). Applicant respectfully traverses this rejection.

The Examiner rejects claim 43 under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of US Patent No. 6,383,596 (*Wiser*). Applicant respectfully traverses this rejection.

Applicant respectfully maintains the arguments from the previous Response with respect to claims 9-11, 13-17, 25-26 and 36 and claim 43. In light of Applicant's arguments herein responsive to the current Office Action, any new aspects of the Examiner's arguments have been addressed, and Applicant respectfully submits that the Applicant's prior arguments remain meritorious. For at least these reasons, claims 9-11, 13-17, 25-26 and 36 and claim 43 are allowable.

It should be noted that any references to the Specification throughout this paper are provided for exemplary illustrative purposes only and do not limit the scope of any claim in the present application.

Reconsideration of the present application is respectfully requested.

Applicant respectfully asserts that in light of the arguments provided throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued. Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4093 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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